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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,646	08/18/2000	Anthony J. Cipolla	13072	6936

7590 05/06/2002

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EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 05/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/641,646

Applicant(s)

CIPOLLA ET AL.

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 49-51 is/are allowed.
- 6) ☒ Claim(s) 1 and 6-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 6-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The presently claimed range of distance of one-half to about 3 inches was not in the disclosure as originally filed and is held to be improper new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-19, 24-26, 29, 32-34, 38, 40 and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (WO 99/37236). Jensen shows a light base 32 having a curved surface and a plurality of light generating devices 40. The output light of Jensen will inherently overlap and form a combined field. The overlapping light will overlap in an infinite number of surfaces including a convex

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surface of relatively uniform intensity. The specific range intensity used is an obvious matter of choice in the degree of a known parameter for light emitting devices to one of ordinary skill in the art. The specific type of light generating devices used is an obvious matter of choice in well known light producers to the skilled artisan. As to claim 14, to use a lens with a light emitting device is well known in the art, and therefore, an obvious matter of choice to one of ordinary skill in the art. As to claim 26, the process of assembly is an obvious matter of choice in the process used to form an obvious structure. As to claims 32 and 33, Jensen emits visible light. As to claim 37, to call the output a lobe is an obvious matter of choice in defining a specific area of the overall light output.

Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (WO 99/37236) in view of Kipke et al. Jensen shows the structure described above, however, does not show the use of LED's. Kipke teaches using LED's at the base. It would be obvious to one of ordinary skill in the art to modify Jensen to include the use of LED's as shown by Kipke in order to place the source in the desired location.

Claims 27, 28, 39, 41, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (WO 99/37236) in view of Kipke et al as applied to claim 20 above, and further in view of Kennedy (711). The above combination does not show a cooling fan nor blue light. Kennedy teaches using a cooling fan as shown and

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teaches the use of blue light, column 3, line 43. It would be obvious to one of ordinary skill in the art to modify the above combination to include a cooling fan to cool the light emitters and to include the use of blue light in order to supply the desired type of light as shown by Kennedy.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (WO 99/37236) in view of Rhoades (851). Jensen shows the structure described above, however, does not show positioning means. Rhoades teaches positioning means in the form of a bite block. It would be obvious to one of ordinary skill in the art to modify Jensen to include the use of positioning means as shown by Rhoades in order to position the device in the desired location.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (WO 99/37236) in view of Nikodem (854). Jensen shows the structure described above, however, does not show a flexible base. Nikodem teaches a flexible base 12. It would be obvious to one of ordinary skill in the art to modify Jensen to include the use of a flexible base as shown by Nikodem in order to position change the shape as desired.

Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (WO 99/37236) in view of Cipolla (159). Jensen shows the structure described above, however, does not show a filter for blocking light. Cipolla teaches a filter 127. It would be obvious to one of ordinary skill in the art to modify Jensen to

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include the use of a filter as shown by Cipolla in order to stop undesirable light, column 5, lines 27-31.

Allowable Subject Matter

Claims 49-51 are allowed. Applicant argues the embodiments of the disclosure and has used means plus function language in the claims, as such, these claims distinguish over the prior art.

All of the claims stand rejected for including new matter. The prior art rejections are based solely on not giving the new matter patentable weight.

Response to Arguments

Applicant's arguments filed February 15, 2002 have been fully considered but they are not persuasive. It is agreed that the prior art does not show the range of intensity at the range of distance as claimed, however, because the range of distance is new matter, it has not been given patentable weight.

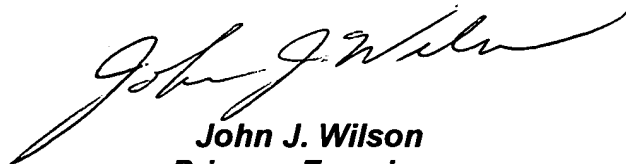
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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.



John J. Wilson
Primary Examiner
Art Unit 3732

jjw

May 5, 2002

Fax (703) 308-2708

Work Schedule: Monday through Friday (flex time)